

REMARKS

Claims 1-19 are pending. No new matter has been introduced. Reexamination and reconsideration of the application are respectfully requested.

In the February 23, 2007 Office Action, the Examiner rejected claims 1-4, 8-11, and 16-19 under 35 U.S.C. §103 (a) as being unpatentable over Murakami et al., U.S. Patent No. 5,131,311 (hereinafter Murakami) in view of Kotani, U.S. Patent Application Publication No. 2004/0126094 (hereinafter Kotani). The Examiner rejected claims 5-7 and 12-15 under 35 U.S.C. §103 (a) as being unpatentable over Murakami in view of Kotani and further in view of Klappert et al., U.S. Patent No. 4,942,551 (hereinafter Klappert). Applicants respectfully traverse the rejections.

In the Applicants November 27, 2007 response to Office Action, Applicants submitted a verified English translation of the Priority Document JP 2003-006114 to perfect the claim for priority in accordance with 37 C. F. R. § 1.451. Applicants noted that the Kotani reference has a filing date of July 22, 2003, which is after the January 14, 2003 priority date of the above-identified application and therefore, requested that the Examiner withdraw the rejection under section 103.

However, in the February 23, 2007 Office Action, the Examiner refused to withdraw the rejection. In doing so, the Examiner states “[The] examiner disagrees with the applicant that Kotani reference was filed July 22, 2003 but has a priority date of document JP2002-224884 filed August 1, 2002.” (*February 23, 2007 Office Action, page 2*)

Applicants respectfully disagree with the Examiner’s determination of the prior art date for the Kotani reference. As the basis for determining the prior art date, the Examiner cites MPEP 2217[R-5](g)(1) which provides “there shall be considered not only the respective dates

of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.” However, MPEP 2138 provides that to qualify as prior art under 35 U.S.C. § 102(g), “there must be evidence that the subject matter was **actually reduced to practice**, in that conception alone is not sufficient.” (*emphasis added*) In addition, MPEP 2138 explains that “While the filing of an application for patent is constructive reduction to practice, the filing of an application does not in itself provide the evidence necessary to show an actual reduction to practice of any of the subject matter disclosed in the application as is necessary to provide the basis for an *ex parte* rejection under 35 U.S.C. 102(g).” Thus, **absent evidence showing an actual reduction to practice (which is generally not available during *ex parte* examination), the disclosure of a United States patent application publication or patent falls under 35 U.S.C. 102(e) and not under 35 U.S.C. 102(g).** (MPEP 2138 citing *In re Zletz*, 893 F.2d 319, 323, 13 USPQ2d 1320, 1323 (Fed. Cir. 1990).

In considering the present application, the Examiner has failed to provide any evidence that the subject matter disclosed in Kotani was made (*i.e.*, actual reduction to practice) in the United States.<sup>1</sup> Accordingly, Applicants respectfully submit that the Kotani reference does not qualify as prior art under § 102(g).

With respect to the effective date of the Kotani reference as prior art under § 102(e), MPEP 2136.03 clearly delineates the prior art date for such a reference. In particular, the heading for this section states in bold, italicized print “***Reference’s Foreign Priority Date Under 35 U.S.C. 119(a)-(d) and (f) Cannot Be Used as the 35 U.S.C. 102(e) Reference Date.***” MPEP 2136.03 also explains that 35 U.S.C. § 102(e) is explicitly limited to certain references “filed in

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<sup>1</sup> 35 U.S.C. 102(g)(2) requires that the invention be “made in this country”.

the United States before the invention thereof by the applicant.” Accordingly, Applicants respectfully submit that the proper effective date of the Kotani reference is July 22, 2003, and thus, the Examiner’s use of the priority date of the Kotani reference (i.e., August 1, 2002) as the reference date is improper.

It is well established that an applicant for patent may overcome a rejection under 35 U.S.C. 102(e) by proving that he or she is entitled to his or her own 35 U.S.C. 119 priority date which is earlier than the references U.S. filing date. *In re Hilmer*, 359 F.2d 859, 149 USPQ 480 (CCPA 1966). In Applicants’ November 27, 2007 response, as indicated above, Applicants submitted a verified English translation of the Priority Document JP 2003-006114 to perfect the claim for priority in accordance with 37 C. F. R. § 1.451. Accordingly, Applicants are entitled to the benefit of the January 14, 2003 filing date of the priority application. Since, the Kotani reference has a U.S. filing date of July 22, 2003, which is after the January 14, 2003 priority date of the above-identified application, the Kotani reference is effectively removed as prior art. Accordingly, Applicants respectfully submit that the rejections under 35 U.S.C. §103 (a) are improper and should be withdrawn.

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In view of the foregoing remarks, Applicants believe that the application is in condition for allowance, and a favorable action is respectfully requested. If for any reason the Examiner finds the application other than in condition for allowance, the Examiner is requested to call the undersigned attorney at the Los Angeles telephone number (213) 488-7100 to discuss the steps necessary for placing the application in condition for allowance should the examiner believe that such a telephone conference would advance prosecution of the application.

Respectfully submitted,

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Date: May 24, 2007

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